

REMARKS

1. Rejection of claims 1-4, 6-8, 10, 13, and 15 under 35 U.S.C. §112, 2nd paragraph as indefinite.

The PTO has indicated that Applicants' use of the phrase "flexible enough to be rolled up" is indefinite. In particular, it is said that this phrase "...lacks a requisite degree. It is unclear how flexible the film is." (Office Action of 12/16/02, pg. 2, paragraph 3.)

(1) (b) (5) CMA (b) (5) DPP (b) (2)
Applicants have amended independent claim 1 in an attempt to fully address the PTO's position. Support for this amendment may be found on page 29, lines 27-29 and page 30, lines 1-3.

Reconsideration and removal of the rejection as to independent claim 1 and dependent claims 2-4, 6-8, 10, 13, and 15 is respectfully requested in as much as all of the dependent claims incorporate the limitations of amended independent claim 1.

2. Rejection of claims 1-4, 6-8, 10, 13, and 15 under 35 U.S.C. §103 as obvious over Muthiah et al., EP 0 844 286 (hereafter "Muthiah" or "EP '286") in view of Craun et al., U.S. 6,184,281, hereafter "Craun" or "US '281".

The prior rejection has been maintained and made final. The rejection is understood to based on the following statements of the PTO:

...The thickness of the substrate is an optimizable feature as it controls the flexibility of the film. It would have been obvious to one of ordinary skill in the art to optimize the components because discovering an optimum or workable range involves routine skill in the art....

Alternatively, or perhaps in addition, the PTO states:

...It would have been obvious to one of ordinary skill in the art to include the removable coating (film) to at least one powder coating layer of EP '286 because Craun teaches the removable coatings are recyclable (abstract) and are therefore environmentally safe.

(Office Action of 12/16/03, pgs 3 & 4, citations omitted.)

Applicants greatly appreciate the PTO's detailed basis of rejection but must respectfully continue to disagree and submit that amended independent claim 1 is patentable over the prior art of record.

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The claimed invention relates to a laminatable film. Support for this amendment may be found on page 5 of the Specification, lines 9-23.

coated layers

The claimed laminatable film must have at least one support layer that is coated with one or more coating layers. The support layer must have a film thickness of between 10 and 1000 μm and must be selected from a group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film. At least one of the one or more coating layers on the support layer must be a thermally curable powder coating or a thermally curable powder coating dispersion. Finally, the laminatable film of the invention must be rollable, that is, it must be able to be rolled up.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP 2143*

Whether the PTO's position is based on a single argument or two alternative arguments, the PTO has failed to provide the *prima facie* case required by *MPEP 2143*.

The PTO's first position appears grounded in the theory that Applicants have merely 'optimized' various features. However, mere optimization does not produce all of the required claim limitations. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974); *MPEP 1243.03* This burden has not been met.

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For example, the cited combination fails to provide a motivation to make a laminatable film having a support layer of a particular thickness and selected from the group consisting of a thermoplastic film, a coated thermoplastic film, and a self-supporting paint film.

The PTO states either, alternatively, or in addition, that "the removable coating (film)" of Craun could be "included" with the "at least one powder coating layer of EP '286" to provide Applicants' claimed laminatable film. Applicants note that it is not clear which of these layers would function as the support layer in this 'construction'.

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However, since Craun is not a powder coating or a powder coating dispersion, it is assumed that the PTO intends for it to be the 'support layer'. - JV

This suggested 'construction' does not provide a *prima facie* case of obviousness for several reasons.

First, EP '286 fails to provide any motivation that either the claimed powder coating layer or any of the disclosed heat sensitive or heat resistant substrates are suitable for use as the support layer of Applicants' claimed laminatable film or as the disclosed coating layer. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)

Applicants also disagree with the PTO's statement that the thickness of the substrate is merely an optimizable feature or is suggested by EP '286. The film builds in EP '286 relate solely to the powder coating layer and do not teach anything with respect to the thickness of Applicants' required support layer. - SO

Both cited references also fail to suggest only those support layer materials that are particularly required by Applicants' claim 1. EP '286 discloses a variety of substrates and is silent as to the importance of flexibility in such substrates. One of skill in the art would not find any motivation to select only those thermoplastic films, coated thermoplastic films, and self-supporting paint films that have a thickness of 10 to 1000 μm . Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q 1673 (CAFC 1988) Nor does either reference indicate how the stripped coating of Craun can function as the support layer. The fact that a stripped coating can be recycled does not suggest that said residue maintains sufficient integrity to function as a support layer that must adhere to the surface to be laminated. It is respectfully submitted that such a strippable coating would be incapable of functioning as the support layer in a laminatable film. Indeed, the '261 patent's discussion of "recycling" is limited to the ability of the crosslinks of the disclosed coating to break down in caustic solutions. There is no mention of the reuse of the removed coating, only of the ability to adhere

taught in art of claim 1

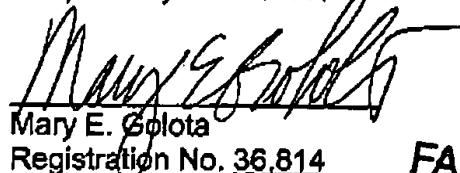
lack support

not

new coatings to the *recycled cleaned plastic bottle*. See '281, col. 6, lines 56-64. It is respectfully submitted that this portion of Craun would lead one of skill in the art away from any use of Craun's strippable coating. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 123 USPQ 349 (CCPA 1959); MPEP 2143.01

It therefore respectfully suggested that the cited combination fails to provide a *prima facie* case of obviousness with respect to amended independent claim 1 and the remaining claims dependent thereon. Reconsideration and removal of the rejection is respectfully requested.

Respectfully Submitted,



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